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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,357	04/05/2001	John Black	9456.5	3915
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KIRTON AND MCCONKIE 1800 EAGLE GATE TOWER 60 EAST SOUTH TEMPLE P O BOX 45120 SALT LAKE CITY, UT 84145-0120			EXAMINER BROOKS, MATTHEW L	
			ART UNIT 3629	PAPER NUMBER

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/827,357	BLACK, JOHN	
	Examiner	Art Unit	
	Matthew L. Brooks	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112 2nd

1. **Claims 1, 8, 15, 22** and all that depend therefrom are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Due to the amendments made (logic set forth below) the term “information” as used is indefinite.

In accordance with these amendments/arguments by Applicant, Examiner is unable to determine the meaning of the word “information” as used in claims 1, 8, 15, 22 and all that depend therefrom. Particularly the problem arises in “...the receiving of prior fight information from at least one user regarding said user’s willingness to consider participation...” Examiner does not see the link in how receiving of prior fight information has much to do with one’s willingness to consider.

Also, the problems raised in the Final Action sent on 8/11/05 still exists. Such as how the prior fight information as laid out in claim 8, for instance, includes willingness to consider, or in claim 11 how a user could locate an agent using said “information”. OR in Claim 16 “selecting a location ...found with in the information organized into an electronically searchable format.” Yet no location data has yet been received, only information regarding prior fight information.

2. **Claims 5 and 12** are rejected for failing to further limit the claim from which it depends, in that of “coordinating an event”. Applicant argues that selling merchandise is inherent with coordinating an event. Examiner disagrees and has applied the

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broadest definition of *coordinating* found with in Merriam Webster OnLine Dictionary. Merriam defines coordinating as 1. put in some order or rank; and 2. to bring into a common action. This definition also corresponds to Applicant's true intent of bringing together a boxing match. However, for purposes of 103 Applicant admits to include selling of merchandise in coordinating an event is old and well known as it is a critical part of the event and therefore would be obvious (See Applicant's Remarks 5/23/05). And to that Examiner agrees if one were using the system in Sutcliffe to align a boxing match the selling of merchandise on the site would be obvious and likewise, merely including a link for the selling of merchandise found with in "angelfire" would be well known.

3. Claims 1, 8, 15 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: found with in the independent claims. Applicant receives information, organizes it, and provides access to the information. However, no coordinating of an event actually occurs. For instance no fight partner is determined, no location is selected and neither is any time or date.

Appropriate action is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1-4, 6-11, 13, 14, and 22-28** as best interpreted by examiner are rejected under 35 U.S.C. 102(b) as being anticipated by Angelfire (attached herein).

As per **Claim 1, 8, and 22** Angelfire discloses:

A method and system for coordinating a competitive sporting event comprising the steps of:

receiving prior fight information from at least one user regarding said user's willingness to consider participation in a particular potential sporting event; (pg D);

organizing said information received from said at least one user into an electronically searchable format (pg D, on a web page, equivalent to e-searchable);

providing access to said information organized into an electronically searchable format to said user and third parties (pg D).

6. With respect to **Claim 2 and 9**:

Angelfire discloses:

the step of proposing a contest in a *sporting* event between at least a first user and a second user (A, (iii); "We are looking for fighters...")

7. With respect to **Claim 3 and 10**:

Angelfire discloses:

the step of organizing a sporting event based on said information through the use of a web site and a wide area network (A-E all found on a web-site on a wide area network).

8. With respect to **Claim 6, 13 and 26**:

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Angelfire discloses:

the step of enabling a first sports participant to challenge a second sports participant in a sporting event using the information organized therein (pg A).

9. With respect to **Claims 7 and 14**:

Angelfire discloses:

the step of providing each of said at least one users with a data storage location accessible by said user and a portion of which is also accessible by selected of said third parties (pg D, if click on users name take to fighters web page).

10. With respect to **Claims 11 and 24**: the means for enabling a sports participant or boxer to locate an agent among said information (pg A, (iii) by emailing SJC to coordinate fight, inherently acting as fighters agent)

11. With respect to **Claim 23**: the means for selecting a location and opponent to box from among other participating boxers found within the information organized into the electronically searchable format. (pg A, (iv)-(v) "Oregon" or Windsor)

12. With respect to **Claim 25**: the means for ranking boxers based on data to enable a participating boxer to select an opponent of similar or advanced data; (pg D, (ii)).

Furthermore, Applicant admits that it is also well known in the art to rank boxers based on data which relates to their ability (Applicants REMARKS, page 8).

13. With respect to **Claim 27**: Angelfire discloses a means to search said information via a wide area computer network (pgs A-E all of which retrieved from the web).

14. With respect to **Claim 28**: Angelfire discloses a means for establishing at least one web page for at least one of said participating boxers, which web page is viewable

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by selected of said third parties. (pg D (ii) in which clicking on links/names will take you to boxers own web profile/page/link).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

17. **Claims 1-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Angelfire in view of Sutcliffe in further view of "insideboxing" (attached herein).

Angelfire teaches all of that shown above, but primarily that the internet was used for matching fighters or coordinating an event on line. Inside boxing teaches retrieving prior fight information in order to further facilitate coordination of a boxing match over the internet (pg 3). Both sites utilize the internet to promote/coordinate a fight it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the type of information collected in insideboxing in angelfire in order to have a

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fully comprehensive information regarding said fighter. Furthermore It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the system/method as taught in Sutcliffe for the purposes of collecting the search criteria/prior fight information and propose matches based upon the characteristic/criterion data entered. Just as Sutcliffe teaches the use of the technology for many such matching/coordinating of event purposes. (see Column 4, 40-43 use form roommate, job listing and Column 6, 9-11 and Column 8, 5-10).

18. **Claims 1-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Angelfire inview Sutcliffe.

19. With respect to Claims **4 and 17 and 22**:

Sutcliffe discloses the steps for enabling a sports participant or user to locate another user among said information; Sutcliffe discloses that a user may conduct a search based upon certain criteria data (2, 30-37).

Sutcliffe does not disclose “per se” the step for enabling a sports participant or boxer to locate an agent among said information; or explicitly using the data to find an agent. However, modifying the terms such as “sports participant and user” to “boxer and agent” is nothing more than modifying the **terminology** within the process of matchmaking which is old and well known with in the art (For support See Applicant’s Specification, Page 27, 3rd Paragraph). Furthermore it is old and well known that boxers need agents to promote them.

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Moreover, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the first and second users of Sutcliffe to include a boxer and agent respectfully. Thus one of ordinary skill in the art would have been motivated to modify the reference as discussed above in order for a boxer to be matched with an agent to promote him/her.

20. With respect to **Claims 5 and 12:**

Sutcliff as described in detail above does not disclose the step of providing electronic commerce for selected third parties seeking to purchase sports-related merchandise associated with a selected sports participant.

However, it is old and well known to providing electronic commerce for selected third parties seeking to purchase sports-related merchandise associated with a selected sports participant.

Furthermore Applicant highlights this in saying (bottom of page 8 and top of page 9 of REMARKS) that “coordinating and event” is well known to include performing all tasks associated with holding an event, including selling merchandise because it is critical in raising revenue.

Sutcliffe clearly teaches coordinating an event, as such Examiner takes Applicant’s statement as admitted prior art that it is well known to include selling of merchandise would be obvious and is old and well known. It would have been obvious to one of ordinary skill at the time of the invention to modify Sutcliffe to include selling merchandise as admitted by Applicant.

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Therefore one of ordinary skill in the art would have been motivated to modify Sutcliffe in order to carry out the critical part of the event of selling merchandise.

21. With respect to **Claim 18**:

Sutcliffe discloses the step of ranking users based on data to enable a participating *user* to select an *opponent/user* of similar or advanced data (presenting requested information to a user in an ordered manner and examiner considers this to be equivalent of ranking Column 2, 24-27).

Sutcliffe does not that the user is a boxer.

Examiner takes note that it is old and well known to rank boxers based upon data. Furthermore, Applicant admits that it is well known in the art to rank boxers based on data which relates to their ability (Applicants REMARKS, page 8).

It would have been obvious to one of ordinary skill in the art at the time of the invention modify the ability to rank based upon characteristic/criteria data entered of Sutcliffe to include ranking of boxers as admitted by Applicant. One of ordinary skill in the art would have been motivated to modify the references in order to present boxers in an ordered manner.

22. Claims **15, 16, 19, 20 and 21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sutcliffe in view of www.angelfire.com/biz2/sjcboxing/match.html effective date of 03/04/2000 on the "Wayback Machine" (herein after "angelfire").

23. With respect to **Claim 15**:

Sutcliffe discloses a method for coordinating an outdoor sport (event) match comprising the steps of:

receiving information from at least one user regarding said user's willingness to consider participating in a particular potential sport (event);

organizing said information received from said at least one user into an electronically searchable format;

providing access to said information organized into an electronically searchable format to said user, to other users, and to third parties. (as described in detail above)

Furthermore, in regards to **claim 16** Sutcliffe discloses the step of selecting a location and opponent to compete in an outdoor sport with from among other participating competitors found within the information organized into the electronically searchable format. Sutcliffe allows users to establish contact (Column 3, 15-20) and propose an event (outdoor sport, etc.), inherently if the boxers/participants were to ever meet (because it is only "potential") inherently the event would have to include the step of selecting a location based upon the information in order to ever become a reality.

Sutcliffe does not disclose that the event is a competitive boxing match and the user is a boxer.

However, "angelfire" teaches that it was known in the art for boxers to use the internet or a website to find a fight for a particular potential boxing match. (See angelfire pg 1, "matchmaking"/"looking for fighters").

Moreover no unexpected results occur by the mere modification of Sutcliffe's user to boxer and outdoor sporting event to boxing match. In both scenarios a "person" enters in characteristic data and another person enters in what they are searching for or criteria data and a match occurs for a particular (whatever the event may be) potential

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(because has not occurred yet) event or boxing match or outdoor sport. Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to modify Sutcliffe in view of “angelfire” to have Sutcliffe’s search criteria to say for example “looking for a boxer” at the time the invention was made in order to organize a boxing match on a website in order to expedite the finding of a suitable boxer for a boxing match.

24. With respect to **Claim 19**:

Sutcliffe discloses the step of enabling a first user to challenge a second user to an outdoor sport (event), using the information organized therein (Sutcliffe: Column 10, 62-68 through Column 11, 1-3 and match data allows one user to establish contact with at least another user Column 3, 1-20).

Sutcliffe does not disclose that the event is a competitive boxing match and the user is a boxer.

However, “angelfire” teaches enabling a first boxer to challenges a second boxer to a boxing match wherein said second boxer may either accept or reject (which is also old and well known). Furthermore, Applicant’s own specification refers to the terms “boxer” versus “tennis player” versus “user” and “boxing match” versus “tennis game” versus “... event” as simply a matter of **terminology** (See Applicant specification, page 27, 3rd full paragraph) and it would be obvious to modify Sutcliffe so that the user is a boxer and the event is a boxing match so that the two boxers may challenge each other.

Moreover no unexpected results occur by the mere modification of Sutcliffe’s user to boxer and outdoor sporting event to boxing match. In both scenarios a “person”

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enters in characteristic data and another person enters in what they are searching for or criteria data and a match occurs for a particular (whatever the event may be) potential (because has not occurred yet) event or boxing match or outdoor sport. Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to modify Sutcliffe in view of "angelfire" to have Sutcliffe's search criteria to say for example "looking for a boxer" at the time the invention was made in order to organize a boxing match on a website in order to expedite the finding of a suitable boxer for a boxing match.

25. With respect to **Claim 20**:

Sutcliffe discloses enabling information organized into an electronically searchable format to be accessed via a wide area computer network (Sutcliffe: Column 4, 17-31).

Sutcliffe does not disclose that the event is a competitive *boxing match* and the user is a *boxer*.

However, "angelfire" does teach this and it would be obvious to modify Sutcliffe so that the user is a boxer and the event is a boxing match as taught by "angelfire." Moreover no unexpected results occur by the mere modification of Sutcliffe's user to boxer and outdoor sporting event to boxing match. In both scenarios a "person" enters in characteristic data and another person enters in what they are searching for or criteria data and a match occurs for a particular (whatever the event may be) potential (because has not occurred yet) event or boxing match or outdoor sport. Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to modify

Sutcliffe in view of "angelfire" to have Sutcliffe's search criteria to say for example "looking for a boxer" at the time the invention was made in order to organize a boxing match on a website in order to expedite the finding of a suitable boxer for a boxing match.

26. With respect to **Claim 21**:

Sutcliffe discloses the step of establishing at least one web page for at least one of said participating user, which web page is viewable by selected of said third parties. Sutcliffe uses the system to provide personal ads in with many components (Column 3, 65-67 through Column 4, 1-5) and presents the personal adds over the internet (Column 4, 18-22) through a plurality of web sites (Column 4, 64-67).

Sutcliffe does not disclose "boxer" and does not disclose that the event is a competitive boxing match and the user is a boxer.

However, "angelfire" does teach this and it would be obvious to modify Sutcliffe so that the user is a boxer and the event is a boxing match as taught by "angelfire. Moreover no unexpected results occur by the mere modification of Sutcliffe's user to boxer and outdoor sporting event to boxing match. In both scenarios a "person" enters in characteristic data and another person enters in what they are searching for or criteria data and a match occurs for a particular (whatever the event may be) potential (because has not occurred yet) event or boxing match or outdoor sport. Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to modify Sutcliffe in view of "angelfire" to have Sutcliffe's search criteria to say for example

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“looking for a boxer” at the time the invention was made in order to organize a boxing match on a website in order to expedite the finding of a suitable boxer for a boxing match.

Response to Arguments

27. First it should be noted that on page 22 of Applicant's specification it is stated that “Any method which provides the function of embodiments of the present invention is to be considered with in scope of embodiments of the present invention.” Applicant proposes a way to collect information of fighters and allow the information to be seen by third parties on a network and then allow said fighters to be challenged to a fight or coordinate a match. This is clearly taught by angelfire, and were Applicant to receive a patent for the claimed invention angelfire would be infringing and angelfire was on the web a year prior to Applicants filing date.

28. With respect to Applicants argument found on page 10, first and second full paragraphs, the amendments made were sufficient to overcome the 102 as taught by Sutcliffe, not however sufficient to overcome angelfire as a reference (see above).

29. In response to Applicants argument pg 10 3rd full paragraph, Applicant states that this type of information has not been available to boxers in the past. However a direct contradiction to that statement is found with in the evidence “insideboxing.com” and “angelfire” which both show the prior fight information available on the web.

Furthermore, the proposed invention does not “empower boxers to become independent of third parties”, rather it just forces them to rely on another third party, the host of the proposed website as is shown in “angelfire”

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30. With respect to pg 11, first full paragraph, Examiner disagrees that no money is involved in the transactions carried out by Sutcliffe (see Column 4, 35-43 wherein Sutcliffe can be used for jobs or finding roommates). Furthermore "angelfire" proposes fights which certainly involve money.

31. With respect to pg 12, first full paragraph, that Sutcliffe is non-analogous art. Examiner disagrees, and points to the facts that if one had possession of "angelfire" and was currently collecting fighter information and needed a system for matching fighters appropriately based upon characteristic/or/criteria data collected utilizing the system/method taught in Sutcliffe, the ultimate matching system. Sutcliffe solves the exact same problem, a user enters in information about themselves and what they are looking for (a match) and then the computer/system proposes matches and enables contact between the two users. As to this information not being available in the past to boxers simply is not a true statement (see angelfire and insideboxing).

Conclusion

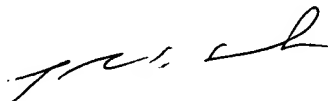
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew L. Brooks whose telephone number is (703) 605-1202. The examiner can normally be reached on Monday - Friday; 8 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-8112. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MLB
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